

Response to Office Action
SN 10/726,801

REMARKS

I. Status of the Claims

Claims 16 and 18-21 are pending.

II. Amendments

Claim 16 is amended to correct antecedent basis. The specification has been amended at paragraph 0025 to correct the informalities pointed out by the Examiner.

III. Objection to Specification

The Examiner has objected to the specification in paragraph 0025. Applicant thanks the Examiner for his detailed reading of the specification. Applicant has amended paragraph 0025 to correct the informalities as suggested by the Examiner. Specifically, Applicant has amended to correct the reference numerals in line 6 of the paragraph.

Applicant respectfully submits that the Examiner's objections have been traversed and that they be withdrawn.

IV. Claim Rejection Under 35 USC §112

Claim Amended to Correct Lack of Antecedent Basis

The Examiner has rejected claims 16 and 18-21 for being indefinite due to a lack of antecedent basis. Applicant thanks the Examiner for his detailed reading of the claims and amends claim 16 accordingly. Applicant respectfully submits that the claims are in form for issuance, and requests that the Examiner withdraw the rejection.

V. Claim Rejections Under 35 USC §102(b)

Wilson Does Not Disclose Adhering A Fastener Into A Bore

The Examiner has rejected claims 16 and 18 as being anticipated by USPN 5,249,899 issued to Wilson. A claim is anticipated only if each and every

Response to Office Action
SN 10/726,801

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051 at 1053 (Fed. Cir. 1987).

Wilson does not disclose, either expressly or inherently, inserting the end of a fastener on which a tacky substance is placed into a bore of a starting tool. Wilson discloses a fastener which contains an adhesive. When the fastener is started into a desired location with a starting tool, the force applied to the fastener by the starting tool causes the adhesive to seep out of predefined channels (29) onto the threads of the shank (16). The adhesive holds the fastener in place in the desired location. It does not enter the starting tool. If it did, the purpose of the adhesive would be defeated as the fastener would be adhered to both the starting tool and the desired location.

In contrast, Applicant's invention provides that the end of the fastener having the tacky substance is inserted into the bore, rather than into the desired location. The tacky substance holds the fastener within the starting tool so that the fastener does not fall out when being guided into the desired location. See specification paragraphs 0020 and 0024. Wilson does not anticipate claims 16 or 18 of the present invention because Wilson does not disclose one element of Applicant's claimed process, namely that the tacky end of the fastener is inserted into the bore.

Because Wilson does not disclose each and every element as set forth in the claims, either expressly or inherently, Wilson does not anticipate Applicant's claimed invention and Applicant respectfully requests that this rejection be withdrawn.

VI. Claim Rejections Under 35 USC §103

A. Fox and Hanny In Combination Do Not Teach or Suggest Adhering A Fastener Into A Bore

The Examiner has rejected claims 16, 18, and 19 as being obvious in light of USPN 3,788,537 issued to Fox in view of USPN 3,485,132 issued to Hanny et

Response to Office Action
SN 10/726,801

al. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP §2143.

As stated by the Examiner, Fox does not teach applying a tacky substance to an end of a fastener and inserting that end into a bore. Hanny teaches applying capsules which contain an adhesive to the outside surface of the fastener. Upon insertion of the fastener into the desired location, the capsules are compressed and break apart, so that the adhesive adheres the fastener into the desired location. The function of the adhesive in Hanny is equivalent to the adhesive in Wilson, and the arguments of Section V, *supra*, are incorporated by reference to show that the purpose of the adhesive in Hanny is defeated if it enters the bore. Therefore, Hanny teaches away from inserting the tacky end of the fastener into the bore as in Applicant's invention because doing so would adhere the fastener equally to the starting tool and the desired location.

Therefore, because the cited references do not teach or suggest one of Applicant's claimed limitations, no *prima facie* case has been established. Applicant respectfully requests that this rejection be withdrawn.

B. Wilson Does Not Teach or Suggest Adhering A Fastener Into A Bore

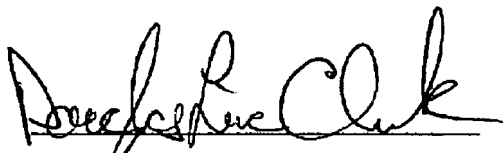
The Examiner has rejected claims 20 and 21 as being obvious in light of Wilson. The arguments of Section V, *supra*, are incorporated by reference to show that Wilson does not disclose inserting the tacky end of a fastener into a bore. Further, the arguments of Section VI. A., *supra*, are incorporated by reference to show that Wilson does not teach or suggest inserting the tacky end of a fastener into a bore. Specifically, the adhesive in Wilson is intended to adhere the fastener into the desired location and does not adhere the fastener into the bore. Inserting the end of the fastener with the adhesive in Wilson would render the invention non-functional.

Therefore, because the cited reference does not teach or suggest one of Applicant's claimed limitations, no *prima facie* case has been established. Applicant respectfully requests that this rejection be withdrawn.

Response to Office Action
SN 10/726,801

VII. Conclusion

Applicant respectfully submits that all objections and rejections have been traversed, and that the application is in form for issuance. Applicant respectfully requests that the Examiner allow the application to proceed to issuance.



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